Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACK W. EISNER

Appeal No. 2000-1195
Application No. 08/668,737

ON BRIEF

Before HAIRSTON, JERRY SMITH, and BARRETT, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 20.

The disclosed invention relates to a method and an apparatus for predicting a sales probability for a sales account at a stage within a sales cycle.

Claims 1 and 16 are illustrative of the claimed invention, and they read as follows:

1. A method for predicting a sales probability for a sales account at a stage within a sales cycle, comprising the steps of:

(a) determining a current stage of the sales cycle for the sales account;

(b) calculating an account control level for the sales account; and

(c) correlating a sales probability based upon said current stage of the sales cycle and said calculated account control level.

16. An apparatus for predicting a sales probability for a sales account at a stage within a sales cycle, comprising:

means for determining a current stage of the sales cycle for the sales account;

means for calculating an account control level for the sales account; and

means for correlating a sales probability based upon said current stage of the sales cycle and said calculated account control level.

No references were relied on by the examiner.

Claims 1 through 20 stand rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter.

Reference is made to the briefs (paper numbers 13 and 16) and the answer (paper number 14) for the respective positions of the appellant and the examiner.

OPINION

We have carefully considered the entire record before us, and we will sustain the 35 U.S.C. § 101 rejection of claims 1 through 15, and we will reverse the 35 U.S.C. § 101 rejection of claims 16 through 20.

According to the examiner (answer, page 3), the claimed invention "contains no practical application," and shows "a series of steps which are grounded in the abstract idea of performing mathematical manipulations of data."

Appellant argues (brief, pages 10 and 11) that:

> [T]he term "sales probability" is not merely just an abstract idea or just a number that requires additional interpretation, but instead is a real, useful and concrete result that has practical application. Namely it provides an answer to a user of the present invention as to whether a sale will or will not likely to occur. Thus, the generation of the sales probability, in and of itself, is the practical application of Appellant's invention. This interpretation is clearly consistent with the holdings of both State Street Bank and AT&T.
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> In support of the Appellant's position that the claimed invention has practical utility, Appellant presently encloses a 1.132 declaration from Mr. Roni Raitosola, a partner at CORRTEC, LLC. CORRTEC, LLC is a company that is engaged in the business of developing, marketing and selling banking software applications to clients. CORRTEC, LLC has recently purchased a software application from the Appellant that embodies the Appellant's claimed invention for use

> in its business. Mr. Roni Raitosola has declared that the purchased software application is useful and practical in predicting the useful information of sales probability for a sales account.

In keeping with AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352, 1356-57, 50 USPQ2d 1447, 1451 (Fed. Cir.), cert. denied, 528 U.S. 946 (1999), and State Street Bank & Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998), cert. denied, 119 S.Ct. 851 (1999), apparatus claims 16 through 20 are clearly directed to a "machine" in means-plus-function format that makes use of a mathematically-related algorithm to produce the practical application of "predicting a sales probability for a sales account." On the other hand, method claims 1 through 15 differ substantially from the method claims in AT&T[1] because they are nothing more than an abstract mathematical algorithm that is totally disembodied from the machine that performs the method steps. Without a recitation of the type of machine for performing the method steps, the method claims on appeal are broad enough to read on a human performing each of the recited steps. For this reason, we agree with the

[1] In AT&T, the method claims expressly stated that they were "for use in a telecommunications system."

examiner (answer, page 4) that the broadly recited method steps of claims 1 through 15 are "not within the 'technological arts'" and do not satisfy the statutory requirements of 35 U.S.C. § 101. Appellant's arguments (reply brief, page 2) to the contrary notwithstanding, the declaration submitted by Mr. Raitosola fails to prove a "practical application" of method claims 1 through 15 because the claims on appeal are not limited to a computer "software program" application. Thus, the 35 U.S.C. § 101 rejection of claims 1 through 15 is sustained because "the resulting correlation is merely an abstract idea without a 'practical application'" (answer, page 5).

DECISION

The decision of the examiner rejecting claims 1 through 20 under § 101 is affirmed as to claims 1 through 15, and is reversed as to claims 16 through 20. Accordingly, the decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

KENNETH W. HAIRSTON Administrative Patent Judge	)
JERRY SMITH Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
LEE E. BARRETT Administrative Patent Judge	)

KWH:hh

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